UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,034	07/23/2002	Ryszard Jurek Kobylecki	1795	6965

24264 7590 12/19/2003		EXAMINER
TIMOTHY J MARTIN, PC		DESTA, ELIAS
9250 W 5TH AVENUE		
SUITE 200	ART UNIT	PAPER NUMBER
LAKEWOOD, CO 80226	2857	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *27* is/are allowed.

6)☒ Claim(s) *1-21, 23, 24, 28-35, 37, 38 and 41-43* is/are rejected.

7)☒ Claim(s) *22, 25, 26, 36, 39 and 40* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 July 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Detailed Action

Drawing

1.   The drawing is objected to because of the following minor informalities:

> Fig. 1: boxes 16, 18, 20, 22 and 42 should be labeled as to function.

Claim Objection

2.   *Claims 5 and 30-43* are objected to because of the following minor

informalities:

> Claim 5: change the phrase "in dependence upon" to "depending upon";

> Claim 30: insert "an" before the word "apparatus";

> Claims 31-40: insert "the" before the word "apparatus";

> Claims 41-43: delete the phrase "use of" before the word "apparatus"

Claim rejection – 35 U.S.C. 112

3.   *Claims 23 and 24* are rejected as failing to define the invention in the manner

required by 35 U.S.C. 112, second paragraph.

A claim in multiple dependent form shall contain a reference, in the alternative

only, to more than one claim previously set forth and then specify a further limitation

of the subject matter claimed. A multiple dependent claim shall not serve as a basis

for any other multiple dependent claim or operational language. Hence, an element in

claim 23 should only incorporate the limitation described in the claims not the claims

(claims 11, 12, 14, 16 and 17) as a whole.

As to claim 24 (dependent claim), said claim is rejected to the extent that it

inherits elements of the base claim or *claim 23*.

Claim rejection – 35 U.S.C. 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection

Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29,

2000. Therefore, the prior art date of the reference is determined under 35 U.S.C.

102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.   *Claims 1-21, 28-35, 37, 38 and 41-43* are rejected under 35 U.S.C. 102(e) as

anticipated by *Turner et al.* (U.S. PAP 2003/0157721).

In reference to claims 1, 28-30, 41 and 42: *Turner et al*. teaches a method of

investigating different physical and/or chemical forms of a material (see *Turner et al*.,

Abstract and Fig. 53). The method includes:

> Providing an array of receptacles each containing material to be investigated

   (see *Turner et al*., Fig. 3, member 104);

> Subjecting the initial material in respective and different receptacles (see

   Turner et al., Fig. 1) to respective different treatments under the control of a

   computer (see *Turner et al*., Fig. 54-58 and 67); and

> Analyzing any material resulting from said different treatments (see *Turner*

   et al., page 2, paragraphs 17-18).

With regard to claims 2, 3 and 4: as noted above in claim 1, *Turner et al*. further

teaches that the method includes associating data relating to the analysis of each

resultant material (content of the reaction vessel at the end of the process) with

information relating to the treatment(s) (property measurements) used to prepare the

resultant material from the initial material (see *Turner et al*., page 3, paragraphs 22-

24). Further, the related data are stored in a computer (see *Turner et al*., Figs. 58, 63

and 67) and the computer is programmed to determine treatments to which initial

material in receptacles is to be subjected (see *Turner et al*., page 1, paragraph 3).

With regard to claim 5: as noted above in claim 2-4, *Turner et al*. further teaches

that the <u>computer</u> determines treatments depending upon the results of the analysis

of resultant material in a first series of experiments using the array of samples (see

Turner et al., Fig. 65 and page 24, paragraphs 263-266).

With regard to claim 6: as noted above in claim 1, *Turner et al.* further teaches

that the initial material is a solid because the materials used in *Turner et al.* have

properties that are attributed to solid materials, such as melting point, glass

translation temperature and degree of crystalline (see *Turner et al.*, page 9, paragraph

122).

With regard to claim 7: as noted above in claim 1, *Turner et al.* further teaches

that the different treatments to which initial material is subjected to prepare

resultant material includes variable(s) relating to the solvent or solvents used in the

treatments (see *Turner et al.*, pages 12-13, paragraphs 158-161).

With regard to claim 8: as noted above in claim 7, *Turner et al.* does not explicitly

teach that the solvent variables are selected from one or more of the variables

associated with the number of solvents used for preparing resultant material from

initial material; a variable relating to the timing of the addition of the solvent or

solvents into a receptacle; a variable relating to the amount of a solvent or solvents

used in a treatment; and a variable relating to the identity of a solvent or solvents

used; however, it is inherent in *Turner et al.* that the chemical reaction would not

have been possible with out consideration of the noted solvent variable because

Turner et al. in pages 19-20, paragraphs 223-225 and page 22, paragraph 248 shows

various solvents used and a timing variable is used to make sure the by product is

realized.

With regard to claim 9: as noted above in claim 8, *Turner et al.* further teaches

that at least two of the solvent variables are varied in a series of experiments (see

Turner et al., pages 19-20, paragraphs 223-224, number of solvents and amount

used).

With regard to claim 10: as noted above in claim 8, *Turner et al.* further teaches

that the implementation of the solvent variables is under the control of a <u>computer</u>

because *Turner et al.* uses a computer program to control and monitor reaction

parameters (see *Turner et al.*, page 3, paragraphs 25-26).

With regard to claim 11: as noted above in claim 1, *Turner et al.* further teaches

that method includes a variable relating to the duration of the treatment of the

initial material to prepare the resultant material (see *Turner et al.*, page 23, paragraph

260).

With regard to claim 12: as noted above in claim 1, *Turner et al.* further teaches

that the method includes a variable relating to the operation of a heating means

during the treatments or heating variable (see *Turner et al.*, Fig. 6 and pages 7-8,

paragraph 113).

With regard to claim 13: as noted above in claim 12, *Turner et al.* does not teach

explicitly that the heating variables are selected from one or more of the variables

related to the time of operation of heating means; a variable related to the duration

of operation of the heating means; and a variable relating to whether operation of

the heating means is continuous or in stages; however, Tuner et al. in pages 7-8,

paragraphs 113-115 teaches various aspects of temperature control for optimum

functionality of the reactor vessel according to the required temperature and heating

requirement of material investigation, hence it is inherent to say that the system

should have one or more of the noted variables in order to carry out the programmed

method.

With regard to claim 14: as noted above in claim 1, *Turner et al.* further teaches

that the method includes a variable relating to the operation of a cooling means

during the treatments or cooling variable (see *Turner et al.*, page 8, paragraph 115).

With regard to claims 15 and 37: as noted above in claims 1 and 30, *Turner et al.*

further teaches that the method includes variables relating to the agitation of

material in the receptacles during treatment or agitation or catalyst variable (see

Turner et al., page 5, paragraph 94).

With regard to claim 16: as noted above in claim 15, *Turner et al.* does not

explicitly teaches that agitation or catalyst variables are selected from one or more of

a variable related to the time of operation of an agitation means for agitating

material; a variable related to the duration of operation of the agitation means; a

variable related to whether operation of the agitation or catalyst means is continuous

or in stages; and a variable related to the rate of operation of the agitation means or catalyst means; however, Tuner et al. in page 5, paragraph 94 inherently teaches that the computer controlled system monitors and administers the catalyst amount, duration in reaction phase, and the rate of operation with continuous or stages monitoring variable.

With regard to claims 17, 34, 35 and 38: as noted above in claims 1 and 30, *Turner et al.* further teaches that a temperature profile is defined for each receptacle in the array and data relating to the temperature profile is stored in said computer (see *Turner et al.*, Figs. 53, 56 and page 21, paragraph 239).

With regard to claims 18 and 31: as noted above in claims 1 and 30, *Turner et al.* further teaches that the method includes supporting the initial material on a porous member, which is porous to fluids but not to said initial material (see *Turner et al.*, page 13, paragraph 162).

With regard to claims 19 and 32: as noted above in claims 1 and 30, *Turner et al.* further teaches that the method includes applying a pressure to prevent solvent(s) passing out of the receptacles, away from said initial material, during treatment of the initial material (see *Turner et al.*, page 10, paragraph 137).

With regard to claims 20 and 33: as noted above in claims 19 and 32, *Turner et al.* further teaches a computerized pressure control method (see *Turner et al.*, Fig. 57).

With regard to claim 21: as noted above in claim 1, *Turner et al.* further teaches that resultant material is analyzed (see *Turner et al.*, page 18, paragraph 208).

With regard to claim 43: as noted above in claim 30, *Turner et al.* further teaches that a multiplicity of treatments of an initial material differ in experimental variable (see *Turner et al.*, page 6, paragraph 102, pressure variation).

Allowance

6.   *In reference to claim 27*: *Turner et al.* does not teach a method of examining the effects in a treatment of a material of varying selected treatment variables that the method including preparing a first resultant material from an initial material using a first treatment using a first set of experimental variables and preparing a second resultant material from an initial material using a second treatment using a second set of experimental variables, wherein the first and second treatments are controlled by a computer.

Allowable Subject Matter

7.   *Claims 22, 25, 26, 36, 39 and 40* are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant disclosure:

> *Blumer* (U.S. Patent 5,082,058) teaches composition and method for

slowly dissolving siliceous material.

> *Carroll et al.* (U.S. Patent 5,556,958) teaches inactivation of pathogens

in clinical samples.

> *Schultz et al.* (U.S. Patent 6,649,413) teaches synthesis and screening

combinatorial array of zeolites

9.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Elias Desta whose telephone number is (703)-

305-3840. The examiner can normally be reached on M-Thu (8:00-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Marc S. Hoff can be reached on (703)-308-1677. The fax

phone numbers for the organization where this application or proceeding is assigned

are (703)-308-5841 for regular communications and (703)-308-5841 for After Final

communications.

Any inquiry of a general nature or relating to the status of this application or

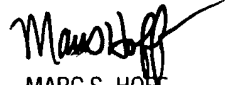proceeding should be directed to the receptionist whose telephone number is (703)-

308-1782.

Elias Desta
Examiner
Art Unit 2857

-ed

December 1, 2003

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800